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Remarks/Arguments

Claims 1-26 are pending in this application. In the instant Office Action the Examiner has rejected claims 1-26 under various grounds of 35 USC §§ 102, 103. The Applicants have currently amended several claims herein to more particularly and distinctly claim the subject matter that Applicants believe to be their invention and not for the purpose of avoiding prior art. No new matter has been added by the foregoing amendments, full support therefor being shown in the drawings and specification as filed. All claims currently in the application are believed to be in condition for allowance. Further examination and reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 USC § 102

Claims 1-2, 4-5, 7-8, 10-12, 14-15, 17-18, 20-22 and 24-25 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,909,326 to Leonberger (Leonberger '326). This rejection is respectfully traversed.

Leonberger '326 discloses a vehicular rearview mirror assembly 3 having a mirror pane 5 provided on a support plate 4 which includes a ball joint so that the tilt of the mirror can be adjusted from the interior of a motor vehicle. Leonberger '326 discloses a first ball-in-socket joint (see, e.g., reference numeral 24) between the support plate 4 and the housing 3 and a second ball-in-socket joint (see, e.g., reference numerals 22, 23) between an intermediate lever 13 and an adjuster flange on the rear of the support plate 4. Manual actuation of control lever 7 transmits an adjustment to the intermediate lever 13 and, thus, to the support plate 4. Leonberger '326 shows simply a manually-controlled tilt actuator for a mirror which is not relevant to the Applicants' invention.

Claim 1 as amended calls for a vehicular rearview mirror assembly, comprising: a base assembly adapted for mounting the rearview mirror assembly to a vehicle, said base assembly including an extension arm extending therefrom; a reflective element attaching to the extension arm for providing an occupant of the vehicle with a rearward view; and wherein the reflective element is slidably movable along the extension arm via a plurality of low friction bearings

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interposed between the extension arm and the reflective element for facilitating movement of the reflective element relative to the base assembly; said plurality of low friction bearings comprising at least one of a ball bearing and a roller bearing.

Claims 2, 4-5, 7-8 and 10-12 depend either directly or indirectly from claim 1 and patentably define over Leonberger '326 for at least the same reasons as claim 1.

Claim 14 calls for a vehicular rearview mirror assembly, comprising: a reflective element mounted to a mounting frame for providing an occupant of the vehicle with a rearward view; an extension arm mounted to a vehicle and moveably attached to the reflective element assembly; and a plurality of low friction bearings interposed between the mounting frame and the extension arm for facilitating movement of the reflective element relative to the extension arm.

Claim 15 depends from claim 14 and patentably defines over Leonberger '326 for at least the same reasons as claim 14.

Claim 17 as amended calls for a vehicular rearview mirror assembly, comprising: a base assembly comprising a base frame for mounting the rearview mirror assembly to a vehicle; at least one support arm for supporting a reflective element and moveably connected to the base frame for selectively folding the reflective element against the vehicle and extending the reflective element away from the vehicle; and a plurality of low friction bearings interposed between the base frame and the at least one support arm for facilitating movement of the reflective element relative to the vehicle.

Claims 18 and 20-22 depend either directly or indirectly from claim 1 and patentably define over Leonberger '326 for at least the same reasons as claim 1.

Claim 24 as amended calls for a vehicular rearview mirror assembly comprising: a base assembly comprising a base frame for mounting the rearview mirror assembly to a vehicle; at least one support arm for supporting a reflective element and pivotably connected to the base frame for selectively folding the reflective element against the vehicle and extending the reflective element away from the vehicle; and a pair of parallel spaced-apart flanges, wherein the at least one support arm is interposed between the parallel flanges to form the pivot connection.

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Claim 25 depends from claim 24 and patentably defines over Leonberger '326 for at least the same reasons as claim 24.

The invention as claimed in claims 1-2, 4-5, 7-8, 10-12, 14-15, 17-18, 20-22 and 24-25 is not found, taught or anticipated by Leonberger '326 and is therefore allowable. Thus, claims 1-2, 4-5, 7-8, 10-12, 14-15, 17-18, 20-22 and 24-25 define over Leonberger '326 and are patentable. Thus, the claims in this application are in condition for allowance.

Claim Rejections – 35 USC § 103

Claims 3, 6, 9, 13, 16, 19, 23, and 26 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Leonberger '326 in view of U.S. Patent No. 4,789,232 to Urbanek (Urbanek '232). This rejection is respectfully traversed.

The Applicants incorporate the discussion of the teachings of Leonberger '326 from above as if fully set forth herein.

The Examiner has asserted that Leonberger '326 lacks the teaching wherein the low friction bearing and the pivot connection comprises a roller bearing and asserts that Urbanek '232 teaches a rearview mirror assembly that comprises a roller bearing, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to simply substitute a ball bearing of Leonberger '326 with a roller bearing described by Urbanek '232.

Urbanek '232 discloses a break-away mounting for vehicular mounted mirrors generally comprising a cam and cam follower arrangement which includes a roller bearing element 56 located within a recess 54 in a guide ring 46 which assists in pivotal movement of the mirror.

The standards for a finding of obviousness must be strictly adhered to. Simply citing one or more prior art references that illustrate different facets of the invention and then concluding that it would be obvious to combine the references to create the applicant's invention is wholly inadequate.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The

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ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact.¹

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention....**Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant....**Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."**

¹ The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

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In Re Werner Kotzab, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The Examiner has failed to identify any motivation, suggestion, or teaching of the desirability of combining Leonberger '326 with Urbanek '232 to arrive at the Applicants' invention called for in the claims. There has been no statement identified in the prior art, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the combined teachings, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for a showing of motivation. The Examiner has failed to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Leonberger '326 and Urbanek '232. Rather, the Examiner has simply relied upon "broad conclusory statements standing alone," which can only lead to the conclusion that the Examiner is simply relying on impermissible hindsight reconstruction of Applicants' invention.

Even if the combination of Leonberger '326 and Urbanek '232 were proper, the combination still would not reach Applicants' invention. Neither Leonberger '326 nor Urbanek '232 discloses the plurality of low-friction bearings as well as the other specifically-claimed features which include, but are not limited to, the lateral extension arm which allows the mirror housing to slide laterally to and from the vehicle. This arm traditionally needs high friction to retain it in place to avoid unnecessary vibration of the mirror with respect to the base.

Thus, claims 3, 6, 9, 13, 16, 19, 23, and 26 are in condition for allowance. Further, these claims are in condition for allowance for the same reasons as set forth above with respect to claims 1-2, 4-5, 7-8, 10-12, 14-15, 17-18, 20-22 and 24-25. Thus, all claims in this application are in condition for allowance.

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Conclusion

For the reasons discussed above, all claims remaining in the application are allowable over the prior art. Early notification of allowability is respectfully requested.

Respectfully submitted,

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Dated: 11/28/05

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